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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Hans Erik SCHMIDT Customer No.: 29,540  
Serial No.: 10/755,755 Group: 3673  
Filed: January 12, 2004 Examiner: M. Trettel  
For: SLEEPING DEVICES COMPRISING A COMBINATION OF  
DOWN FILLING AND A TEMPERATURE REGULATING  
MATERIAL

**TRANSMITTAL OF APPEAL BRIEF**

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P.O. Box 1450  
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S I R:

Enclosed is an original brief to the Board of Patent Appeals and Interferences and three photocopies. This Brief is being filed pursuant to the Notice of Appeal dated March 1, 2006 in response to the final Office Action of November 22, 2005. The fee for filing an appeal brief is enclosed. Any other fees may be charged to Deposit Account 50-1145, Order No. 2424-30.

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

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Application Serial No. 10/755,755

Filed: January 12, 2004

Art Unit: 3673

Examiner: Michael Trettel

**SLEEPING DEVICES COMPRISING A COMBINATION OF DOWN FILLING AND A  
TEMPERATURE REGULATING MATERIAL**

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Ex parte: Hans Erik Schmidt

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BRIEF FOR THE APPELLANTS

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Attorneys for the Appellants

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I. REAL PARTY IN INTEREST

The real party in interest is assignee Quilts of Denmark A/S.

II. RELATED APPEALS AND INTERFERENCES

None

III. STATUS OF CLAIMS

Claim 2 is rejected and is being appealed herein.

IV. STATUS OF AMENDMENTS

No after-final amendments were filed in response to the final Office Action of November 22, 2005. The Notice of Appeal was filed March 1, 2006 along with a request for a one month extension of time.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is directed at a sleeping device, such as a pillow, mattress, or quilt (Specification p. 1, ll. 26-27; Fig. 1, Nos. 101, 103, 105), which is adapted to be used by a person during rest and which improves sleep and particularly REM sleep (Specification p. 2, ll. 3-5) by minimizing temperature variations of the body during sleep. (*Id.*) To this end, the sleeping device comprises a first layer of a phase change material (PCM) (Specification p. 2, ll. 14-15; Fig. 1., Nos. 113, 121, 131) and a second layer made up of down filling. (Specification p. 1, ll. 31-32; Fig. 1 No. 111). The combination of the PCM and down filling layers provides for uninterrupted sleep by minimizing temperature variations while providing for sleeping comfort. (Specification p.2, ll. 4-6).

VI. GROUND OF REJECTION TO BE REVIEWED UPON APPEAL

1. Is Claim 2 patentable under 35 U.S.C. §103(a) over the Buckley reference (U.S. Patent No. 5,722,482)?

VII. ARGUMENT1. Is Claim 2 patentable under 35 U.S.C. §103(a) over the Buckley reference (U.S. Patent No. 5,722,482)?

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and should not be based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The present Claim 2 is specifically directed at a sleeping device for minimizing temperature variations during sleep. To this end, the sleeping device comprises a first layer of a phase change material (PCM) and a second layer made up of down filling. The combination of the PCM and down filling layers provides for uninterrupted sleep by minimizing temperature variations while providing for sleeping comfort. The down filling provides moisture absorbing properties superior to other insulating materials, e.g. fiber filling (Specification at p.1, l. 33 – p.2, l.3) and thereby increases the functionality of the PCM material.

Appellant respectfully submits that the examiner has failed to make out a *prima facie* case of obviousness of the claimed invention in light of the Buckley reference. First, the examiner has not set out a motivation to modify the teachings of Buckley so as to render obvious the claimed invention. In order to support the conclusion that the claimed invention is directed

to obvious subject matter, the examiner has the burden of demonstrating that the references either expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

The examiner has not done so in this case. Buckley discloses the use of a PCM material in various products in combination with various plastic foam insulating materials. Buckley does not teach the use of PCM material in combination with a down filling layer. The examiner takes notice of the fact that foam is specified as being the preferred material in the Buckley reference (8/10/05 Office Action at page 2, lines 20-21) and further asserts that a large class of materials are available which qualify as insulating materials. Such materials include but are not limited to down, feathers, textiles such as cotton or polyester materials, wool, latex foams, and so forth. (*Id.* at ll. 21-24).

However, the Examiner has made no demonstration of how the Buckley reference teaches potential modifications of its disclosed plastic foam insulating layers to encompass such a large and disparate class of materials possessing widely varying physical characteristics. The Examiner's claim of alleged equivalence of plastic foam and down insulating layers is thus no more than an assertion that the claimed invention's use of down in conjunction with PCM material is "obvious to try", which is not a legitimate test of patentability. *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed.Cir.1987); *In re Goodwin*, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978).

Second, the appellant respectfully submits that the examiner has not demonstrated a reasonable expectation of success. The examples given in Buckley for the various PCM

products are in extremely active environments with extreme temperature variations of the body, such as biathlons (Col. 10), diving (Col 14), skiing (Col. 17) etc. Indeed, the blankets having a PCM, but not a down filling, layer suggested by Buckley are for treating hypothermia or fever patients which again are a situation with extreme temperature variations of the body.

The Examiner suggests that the intended use of the claimed invention as a sleeping device is inherently anticipated by the Buckley disclosure. However, there is nothing in the Buckley reference that inherently suggests the use of a PCM layer in conjunction with down filling in a sleeping device. The examiner has not demonstrated how the use of PCM clothing materials designed for use in extreme temperature environments and in conjunction with foam insulating materials would inherently perform the same function as down filling in increasing the functionality of the PCM layer. Thus, it is respectfully submitted that the Examiner has failed to establish a reasonable expectation of success as to the use of PCM in the context of the claimed invention.

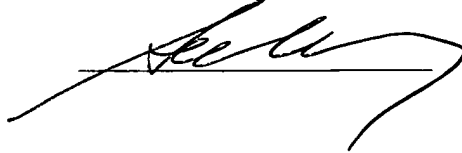
As a result, it is respectfully submitted that the Examiner has failed to show that either a teaching or suggestion to modify the Buckley reference or a reasonable expectation of success was found in the Buckley reference. As noted *supra*, the Examiner has demonstrated only that, based on the disclosure of the present invention, Buckley might be modified so as to make it "obvious to try" every possible insulation material—an assertion unsupported by the disclosure of the Buckley reference. Further, the nature of the invention described in the Buckley reference – that is, use of PCM in extreme temperature environments and in conjunction with foam insulating material– neither demonstrates that the Buckley reference would be inherently capable of meeting the use of the claimed invention nor engenders a reasonable expectation that the



Buckley reference's teachings could be modified so as to read onto all elements of the presently claimed invention.

The Board is respectfully requested to find all of the presently pending claims to be allowable.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Gerald Levy', is written over a horizontal line.

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VIII. CLAIMS APPENDIX

Claim 1 (cancelled).

Claim 2 (previously presented)      A sleeping device, such as a pillow, mattress or quilt, for minimizing temperature variations during sleep, wherein the sleeping device comprises a first layer (113,121,131) of a phase change material having temperature regulating properties and a second layer of down filling (111,123,129).

Claims 3-9 (cancelled).

IX. EVIDENCE APPENDIX

None

X. RELATED PROCEEDING APPENDIX

None